

REMARKS

By this Office Action, the Examiner has required further restriction to one of the following inventions in prior elected group IV, under 35 U.S.C. §121:

- I. Claim 16, drawn to a method for identifying agent compounds capable of inhibiting 27-hydroxy-7-dehydrocholesterol reductase activity by measuring enzyme activity, classified in class 435, subclass 7.1.
- II. Claim 17, drawn to a method for identifying agents capable of interfering with the expression of 27-hydroxy-7-dehydrocholesterol reductase activity by measuring RNA expression, classified in class 436, subclass 94.

Responsive to the Requirement for Restriction, Applicants elect to prosecute the invention of Group II, with traverse, claim 17, which is drawn to a method for identifying agents capable of interfering with the expression of 27-hydroxy-7-dehydrocholesterol reductase activity by measuring RNA expression.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are ""independent"" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term ""distinct"" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claim 16 of Group I is drawn to a method for identifying agent compounds capable of inhibiting 27-hydroxy-7-dehydrocholesterol reductase activity by measuring enzyme activity that are fundamentally related to Claim 17 of Group II, drawn to a method for identifying agents capable of interfering with the expression of 27-hydroxy-7-dehydrocholesterol reductase activity by measuring expression. The search for any of the methods separately classified by the Examiner as the invention of Group I would require an additional search of the identical classes wherein the methods of Group II are classified, thus resulting in a duplicate search for the same material. The method of Claim 17 and Group II is directed to identifying a compound/compounds capable of inhibiting the expression 27-hydroxy-7-dehydrocholesterol reductase, while the invention of Claim 16 and Group I is similarly directed to identifying a compound/compounds capable of inhibiting 27-hydroxy-7-dehydrocholesterol reductase activity. These methods involve and invoke overlapping steps and activities. While there may be some distinct aspects, there are significant overlapping aspects, and Applicants assert that the search and examination of the methods of both Groups I and II can be made without significant burden. In addition, the references relevant to the method of Group I will most likely speak to the features and parameters of the method of Group II, as both enzyme activity and expression would be expected to be discussed in the same publication.

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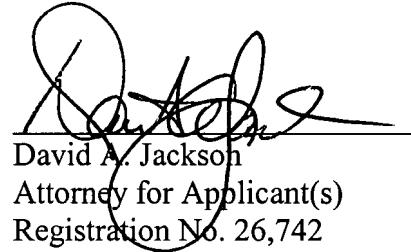
Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group I with Group II as set out in this restriction requirement can be made without serious burden, and therefore request that the Examiner examine both of the Groups I and II and claims 16 and 17 of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the claims of the present Application in Groups I and II of this restriction requirement would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group II is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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